

Appl. No. 08/932,784
Reply Filed: May 3, 2005
Reply to Office Action of: November 3, 2004

REMARKS

In response to the Office Action of November 3, 2004, the Applicant submits this Reply. In view of the foregoing amendments and following remarks, reconsideration is requested.

Claims 1, 9 and 23 remain in this application, all of which claims are independent and have been amended. No fee is due for claims for this amendment.

In the Office Action, claims 1, 9 and 23 were rejected.

The prior Office Action (May 8, 2002) in this application included a rejection of the claims in view of Peters, Bohrman and Osamu. This rejection was not repeated in the Office Action of November 3, 2004, and, accordingly, the Applicant understands that rejection to have been withdrawn.

Provisional Obviousness-type Double Patent Rejection

In the Office Action, claims 1, 9 and 23 were provisionally rejected for obviousness-type double patenting in view of claim 5 of Ser. No. 08/932,993, which has now been allowed.

For expediency, the Applicant submits herewith a Terminal Disclaimer to obviate any nonstatutory double patenting rejection between this application and the issued patent, to which this application claims priority. By submitting this Terminal Disclaimer, Applicant does not admit to the propriety of any nonstatutory double patenting rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District* 946 F.2d 870, 20 USPQ2d 1392 (Fed.Cir. 1991).

Amendments to the Claims

Claims 1, 9 and 23 have been amended to clarify that the specification or definition of a sequence of segments is done by the individual. Further, the amendments clarify that the segments that can be specified by an individual are segments of the sequences of digital still images "stored on the digital computer-readable and writable random-access medium." Finally, the amendments clarify that sequences of digital still images are read from the digital computer-readable and writable random-access medium according to the defined sequence of segments.

Overview of Reply

The three rejections of the Office Action attempt to combine different prior art in different ways to arrive at the claimed invention. As noted below, however, none of the prior art

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teaches or suggests that a camera should be in the same portable housing as a means that enables an individual to specify or define sequences of segments of sequences of digital still images stored on the digital computer-readable and writable random-access medium.

In particular, in all of the references relied upon in the Office Action to describe a mechanism for specifying sequences of segments of stored video material (namely, Peters, Bluth and Freeman), *none* of them teaches or suggests that a camera should be combined with such mechanisms in a portable housing. Notably, all of these references mention the capability of recording video from a camera, yet do not suggest combining the editing and recording in the same portable housing.

Furthermore, in all of the references cited in the Office Action that describe cameras in some detail (namely, Kojima, Washino I, Washino II, Bluth and Osama), *none* of them teaches or suggests that a camera should include within its housing a mechanism for enabling a user to specify sequences of segments of *stored* video material.

Also, the three rejections are formulated in a way that does not guard against the use of impermissible hindsight reconstruction. Two requirements are designed to protect against the use of hindsight. First, obviousness rejections "must be based on objective evidence of record." *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Second, the prior art references *when combined* must teach or suggest all the claim limitations. See MPEP 2143 (emphasis added).

In all of the rejections, the reasons for the proposed combinations lack citations to any evidence for support. The assertions are nothing more than generalized statements of advantage, without regard to either the desirability or the feasibility of modifying the prior art and without any supporting citations to any authority. That is, the Office Action does not establish in the record *any* evidence – either from the references cited, or other evidence or even Official Notice – from which one can conclude that "a skilled artisan, *with no knowledge of the claimed invention*, would have selected . . . components [from these references] for combination in the manner claimed." *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000, emphasis added). As an example, the Office Action on page 8, lines 6-12 states:

"The combination of a camera, recorder or computer and an editing means in the same housing would provide advantages to the user in handling capturing desired motion pictures and convenience to the user in selecting the sequences of the stored digital images to be played back for viewing or

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editing. Providing the advantages and conveniences to the user is the reasons to motivate one . . . to combine [the references]."

Because such assertions about advantages and convenience are made without any reference to any evidence to support them, it has not been demonstrated that these advantages and conveniences were apparent to those of ordinary skill in the art at the time the invention was made. As noted by the Federal Circuit, "this factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority." *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

In the absence of appropriate evidence in the record, a requirement designed to avoid the "subtle but powerful attraction of a hindsight-based obviousness analysis" (see *in re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999)), a *prima facie* case of obviousness has not been established.

In all of the rejections, each reference was first characterized by comparing it to the claim language. In turn, the proposed combinations of references are described as combinations of claimed elements, not as combinations of the teachings of references. Thus, instead of making "particular findings . . . as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected . . . components for combination in the manner claimed," (*in re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000, emphasis added)), the entire analysis of the collective teachings of the references is wrapped up in the claim language. Thus, the rejections are improper to the extent that factual findings regarding the collective teachings of the cited references rely on the claim language instead of the prior art.

For these reasons, and for the reasons below, the rejections in this Office Action are traversed.

Rejection Under 35 U.S.C. §103 in view of Peters and Kojima

Claims 1, 9 and 23 were rejected under 35 U.S.C. §103 in view of U.S. Patent 5,946,445 ("Peters") and U.S. Patent 5,168,363 ("Kojima"). The rejection is respectfully traversed.

According to Peters, a system stores audio and/or video material digitally such that it can be randomly and immediately accessed. See Col. 2, lines 17-21. In Fig. 1 of Peters, "analog video sources 1 and analog audio sources 2 are received by video coprocessor 3 and audio coprocessor 4." Col. 2, lines 30-32. "Each of the coprocessors digitizes incoming material and stores it on storage devices 5." Col. 2, lines 35-36. Separate files are created in response to a

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discontinuity in the video information received. See Col. 2, lines 50-65. Fig. 1 illustrates that sources of analog video received by the media recorder include a video camera or a video assist of a film camera. "The storage of clips on disk . . . allows multiple clips to be played back in sequence." Col. 3, lines 32-34. The computer and video system in Fig. 1 can be designed for portability. See Col. 3, lines 43-45.

In summary, Peters teaches a portable computer system that receives a video signal and stores video information in data files on a digital random-access computer readable and rewriteable recording medium.

The Examiner acknowledges that Peters "fails to specifically teach that the motion camera mounted in the housing having the recorder. [sic]" Office Action, page 3, lines 18-19. It is probably more accurately stated that Peters fails to teach that the camera is mounted in the housing that includes *both* the recording functions *and* the functions for enabling an individual to specify sequences of segments of stored video.

According to Kojima, in Fig. 1 and Col. 1, lines 5-10, Kojima relates to a "video signal processing apparatus for use with a video tape recorder (VTR) with a built in camera." Thus, Kojima is being used for teaching nothing more than the fact that it is common to have a combined camera and VTR, commonly called a camcorder.

The Office Action asserts that it would have been obvious to combine the teachings of Peters and Kojima, by providing a motion camera in the same housing of the digital recorder, "for portability's purpose therefore providing more advantages to the user in handling the apparatus for capturing the pictures when needed." Office Action, page 4, lines 2-4.

The rejection is traversed for several reasons.

First, the Office Action does not set forth a *prima facie* case for combining of the teachings of Peters and Kojima. In particular, the Office Action lacks citations to any evidence in support of the proposed reasons for combining Peters and Kojima in the manner suggested. The assertion relied upon in the Office Action is nothing more than a generalized statement of advantage, without regard to either the desirability or the feasibility of modifying the prior art and without any supporting citations to any authority. That is, the Office Action does not establish in the record *any* evidence – either from the references cited, or other evidence or even Official Notice – from which one can conclude, from the mere existence of a camcorder (exemplified by Kojima), that one of ordinary skill in the art would have found it both desirable

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and feasible to modify Peters so as to include a camera in a portable housing that also includes *both* a computer-readable medium on which video is stored *and* functions for enabling an individual to specify a sequence of segments of stored video.

Second, one of ordinary skill in the art would not have been motivated to combine the teachings of Kojima and Peters. As noted above, Peters in essence teaches a portable computer system that receives a video signal and stores video information in data files on a digital random-access computer readable and rewriteable recording medium. Peters states that the computer system can be portable for use in on-site live recording and mentions receiving a signal from a camera, yet Peters does not teach or even suggest that a camera should be included as part of that portable system.

Accordingly, in view of the lack of evidence established in the record and lack of motivation from the prior art to combine Peters and Kojima in the manner proposed, this rejection of claims 1, 9 and 23 is traversed.

Rejection Under 35 U.S.C. §103 in view of Bluth and Washino I

Claims 1, 9 and 23 were rejected under 35 U.S.C. §103 in view of U.S. Patent 3,617,626 (“Bluth”) and U.S. Patent 5,537,157 (“Washino I”). This rejection is respectfully traversed. Notably, Bluth was cited, but not applied, in the prior Office Action of May 8, 2002.

This rejection is improper and should be withdrawn because neither Bluth nor Washino I, nor their combined teachings, teaches or suggests the limitations of the independent claims regarding any function, within a portable housing, for enabling an individual to specify sequences of segments of stored video.

In particular, the Office Action asserts, at page 4, line 9, that Bluth teaches a “housing sized to be portable for use by an individual,” referring to Fig. 1 of Bluth. No such housing is shown in Fig. 1 of Bluth. Instead, Fig. 1 is referred to as a “system” throughout Bluth. There is nothing in Bluth that teaches or suggests that all of the components of this system, particularly editing, are found in a portable housing. In the Applicant’s prior reply of July 18, 2002, the Applicant also pointed out the fact that Bluth does not include editing functions in a camera.

According to Washino I, Col. 6, lines 31-44:

“Fig. 2a shows a camera A lens 2 and viewfinder 4 are mounted upon the body of the camera frame. The usual optical-splitter, CCD-sensors and driver circuitry, and

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digital signal processing circuitry are located at 6 . . . The various analog and digital output signals and any input audio, video or control signals, all shown generally at 16, are interfaced through appropriate connectors disposed on the rear-panel 12 and sub-panel 14. Provisions are included a shown [sic] for the input of analog audio signals, and for the output of both analog and digital audio signals. . . . Internal video recording facilities 8 are described herein below."

Regarding the storage 8 in Fig. 2a, Washino I further states at Col. 8, lines 29-47:

"For this application, a data storage unit 8 is provided to facilitate editing and production activities, and it is anticipated that these units would be employed in much the same way as video cassettes are currently used in Betacam and other electronic news gathering (ENG) cameras and in video productions. This data storage unit may be implemented by use of a . . . disk drive with removable storage media, or by a removable disk-drive unit . . ."

Washino I states that editing functions are performed in a personal computer. In particular, Washino I states, at Col. 2, lines 45-51 (which is cited in the Final Office Action at page 2, lines 14-15), the following (with emphasis added):

"In the preferred embodiment, specialized graphics processing capabilities are included in a high-performance personal computer or workstation, enabling the user to edit and manipulate an input video program and produce an output version of the program in a final format which may have a different frame rate, pixel dimensions or both."

Washino I also states, at Col. 3, lines 54-60 (which is cited in the Final Office Action at page 2, lines 14-15), the following (with emphasis added):

"The system . . . allows an operator to control equipment . . . at a centralized personal computer to produce, edit and record a video program. Each camera to be used with the system . . . feeds a signal to the personal computer . . ."

The Office Action asserts that one of ordinary skill in the art would have combined the teachings of Bluth and Washino I "by using a processing means as taught by Washino I for processing the motion picture from the camera into sequence of still images that can be recorded and read on and from a digital computer random access medium thereby enhancing the function of the apparatus of Bluth to facilitate accessing and retrieving the stored digital motion picture when needed." Office Action, page 5, lines 8-12. No citation to any evidence regarding the desirability or feasibility of such a combination is provided.

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Regardless of the propriety of the proposed combination of Bluth and Washino I, neither Bluth nor Washino I teaches a housing sized to be portable by an individual that includes both a motion video camera and a means that enables the individual to specify or define a sequence of segments of stored sequences of digital still images as claimed in claims 1, 9 and 23. Bluth fails to teach the claimed portable housing, and thus fails to teach a portable housing that includes a camera and functions for enabling an individual to specify sequences of segments of stored video. In Washino I, any housing that contains a camera does not contain functions for enabling an individual to specify sequences of segments of stored video.

Because neither Bluth nor Washino I teaches or suggest a "housing sized to be portable by an individual" that includes both a motion video camera and functions for enabling the individual to specify or define a sequence of segments of stored sequences of digital still images as claimed in claims 1, 9 and 23, the rejection of claims 1, 9 and 23 in view of Bluth and Washino I is traversed.

Rejection Under 35 U.S.C. §103 in view of Washino II, Freeman and Osamu

Claims 1, 9 and 23 were rejected under 35 U.S.C. §103 in view of U.S. Patent 5,488,433 ("Washino II") and U.S. Patent 5,579,239 ("Freeman") and Japanese Patent Application 3-314435 with Publication Number 5-153448 ("Osamu"). The rejection is respectfully traversed.

As a point of clarification, this application has a filing date of February 23, 1995, whereas Washino II has a filing date of March 1, 1995. However, Washino II purports to be a "continuation-in-part" of two other patent applications, namely 08/298,104, filed August 30, 1994, now U.S. Patent 5,537,157 (Washino I), and 08/050,861, filed April 21, 1993, now U.S. Patent 5,450,140 (the "140 Patent"). For the sake of clarity, it is assumed that the Examiner is applying Washino II only to the extent that it incorporates the subject matter of those two other patent applications.

According to Washino II, a camera includes a lens and viewfinder mounted on the body of a camera frame, and usual signal processing circuitry. See Fig. 1 and Col. 3, lines 20-30 (See Fig. 2a, Col. 6, lines 31-35 of Washino I). The video information may be compressed. See Col. 4, line 57 to Col. 5, line 2 (and Col. 9, lines 15-23 of Washino I). The video information may be stored on a hard disk drive 70. See Fig. 2 and Col. 4, line 17 (and Fig. 3, and Col. 8, line 58 of Washino I).

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The Examiner acknowledges that "Washino [II] . . . fails to specifically teaches [sic] an editing means in the housing of the camera for specifying a sequence of the stored digital picture." Office Action, page 6, lines 3-4.

According to Freeman, a remote video transmission system includes a remote unit where an input video signal is captured, compressed, digitized and transmitted to a host unit. See Abstract, first line and Col. 4, lines 8-10. The remote unit may receive a video signal from a video camera or other source. See Col. 4, lines 28-31. The remote unit may be a portable personal computer. See Col. 4, lines 17-18. Freeman also states, at Col. 2, line 63 to Col. 3, line 7, that:

"Computer software loaded on a hard disk drive in the remote unit instructs it to capture the input signal to a video capture card within the remote unit. The video capture card takes the audio/visual signal, digitizes it into a computer data file, and compresses that data file. Once digitized and compressed, the data file is captured in the computer's memory by a capture module on the video capture card. A software sequence then instructs the computer central processing unit to store the captured data file on the computer's hard disk drive. After the video file has been captured, it may be edited as desired prior to transmission to the host unit."

The Examiner refers to Col. 6, lines 8-20 of Freeman for teaching editing, but this portion of the reference does not discuss editing. Col. 6, lines 30-35, however, states that:

"VIDEO FOR WINDOWS provides the system the capability for editing a captured data file on the remote unit . . . As the file is being viewed, sequences may be deleted or edited together as desired."

According to Freeman, VIDEO FOR WINDOWS was a computer software program available from MicroSoft [sic] (Col. 4, lines 42-44), that "allows for editing of a data file once captured" (Col. 4, line 67). According to Freeman, "other software packages . . . may be substituted for VIDEO FOR WINDOWS." Col. 4, lines 45-48. This editing capability is not in a portable housing that also includes a camera.

Osamu teaches an integrated camera and video tape recorder. See Applicant's Translation, page 6, "Working Example". The problem Osamu addresses is that the increased number of control buttons for each added function and the size and spacing of these control

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buttons have made them "more difficult to use and has increased the likelihood of mistakes." Applicant's Translation, page 4, "Problem Solved by the Invention". According to Osamu, this problem is addressed by a camera that has "a panel that can be open and closed" and "a monitor . . . situated inside the panel for viewing . . . images." Applicant's Translation, page 5, "Means for Solving the Problem". The "control buttons used to record, play back and edit video images are located inside on [a] panel or on the main body of the video camera enabling the control buttons to be operated when the panel is open." Applicant's Translation, page 5, "Means for Solving the Problem". Other control buttons "do not work when the panel is open." Applicant's Translation, page 5, paragraph 0008.

Osamu teaches that some of the control buttons are used for "editing video images." See Applicant's translation, in the following paragraphs: "Constitution," "Claim 1," "Claim 3," "Means of Solving the Problem," "0008," "0013," "0017" and "0020." These control buttons are only among control buttons labeled 121-137 in Fig. 2 and 161-180 in Fig. 4. See Applicant's translation, paragraphs "0013" and "0020." The only specific functions described by Osamu for "editing video images" are "fade in, fade out and create digital titles." These functions are invoked by control buttons 121-137 "while photographing and recording images" (paragraph "0014") or "during the recording process" (paragraph "0005"). The other buttons, because they are disabled, "are unlikely to cause a recording error." Applicant's translation, paragraph "0015."

Osamu therefore teaches a video tape recorder integrated with a camera that has fade in, fade out, digital titling, and other operations on video images that are performed during the recording process.

The Examiner acknowledges that "Washino as modified with Freeman fails to teach that the editing means [is] mounted in the housing of the recorder." Office Action, page 6, line 15-16. The alleged combination of Washino and Freeman is further modified in the Office Action "by using the teaching as suggested by Osamu to install the editing means as taught by Freeman within the recorder of Washino thereby provide more convenience to the user in handling the editing the captured digital motion data. [sic]" Office Action, page 6, last 4 lines.

The proposed combination of Washino, Freeman and Osamu is based on reasoning that would require additional findings of fact that are not supported by evidence in the record. The Office Action relies upon a narrow, specific teaching in Osamu (namely, control buttons 106-120 are used to switch modes, change shutter speed, fade in, fade out and create digital titles during

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recording), as a general teaching that any function that might be characterized as editing may be placed within the housing of a video recorder. The Examiner has not provided any evidence that Osamu would have been understood by one of ordinary skill in the art, at the time the invention was made, as teaching anything more than it specifically does. To the contrary, the Examiner admitted in a prior paper that Osamu fails to teach any editing that involves specifying a sequence of segments of a stored sequence of digital still images. See Advisory Action of August 13, 2002, page 4, lines 5-6.

Furthermore, the generalization of Osamu's teaching of specific functions (such as switching modes, changing shutter speed, fading in, fading out and creating digital titles) to other types of editing is not supportable. In particular, Osamu describes functions that are performed on images before they are recorded on a tape, and not functions that are performed on sequences of images recorded on the computer-readable medium as required by the claims. Also, editing, as shown in Freeman for example, is provided by Microsoft's Video for Windows program. Such software is clearly different from simply pressing a control button in Osamu to perform a fade operation during recording.

The Examiner also asserts, in support of the proposed combination, that such a combination would "provide convenience to the user." Final Office Action, page 11, lines 8-14, for example. This assertion also is not supported by any evidence that one of ordinary skill in the art, at the time the invention was made, would have recognized that such convenience could be successfully obtained. Osamu's specific teachings about controls for switching modes, changing shutter speed, fading in, fading out and creating digital titles are insufficient to suggest that it also would have been recognized as both desirable and feasible to also have, in the same portable housing as a camera and recording system, an editing system such as Video for Windows for enabling a user to specify a sequence of segments of stored sequences of digital still images.

In summary there is no evidence supporting findings, for example but not limited to, that one of ordinary skill in the art, at the time the invention was made, would have recognized that:

- a. Osamu teaches something more than it specifically does;
- b. the prior art permits a broad generalization of Osamu's teachings of specific editing operations on images before they are recorded on a tape in a camera to any kind of editing, and specifically operations on recorded sequences of images in a camera; and

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c. The capability to edit sequences of segments of stored sequences of images in a portable video camera would have been considered by one of ordinary skill in the art to be both desirable and feasible.

The outstanding rejections are inherently based on at least such findings of fact and no evidence has been provided in the record to support such findings. As noted by the Federal Circuit, "this factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority." *in re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Because the record lacks evidence required to support the findings of fact on which the rejection is based, it cannot be held that the references relied upon by the Examiner would have combined in the proposed manner by one of ordinary skill in the art at the time the invention was made.

Accordingly, this rejection of claims 1, 9 and 23 in view of Washino, Freeman and Osamu is traversed.

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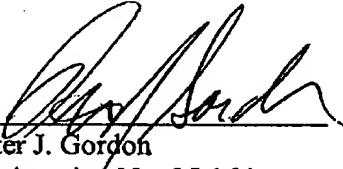
CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this reply, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, please charge any fee to **Deposit Account No. 50-0876**.

Respectfully submitted,

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